

Appl. No. 10/522,116
Amd. Dated April 11, 2007
Reply to Office Action Dated March 12, 2007

Remarks/Arguments:

In the Office Action mailed on March 12, 2007, Examiner required Applicant to elect a single disclosed species for prosecution on the merits. Applicants traverse the restriction requirement, provisionally electing to prosecute the Species A1 and B1, i.e. claims 1 to 31 and 35. Claim 35 is amended to more distinctly point out and claim the invention.

However, it is the Applicant's opinion that the restriction requirement is defective.

The current application No.10/522,116 is the national phase of PCT case PCT/GB2003/003090. This case entered the national phase at the USPTO on January 24, 2005.

According to MPEP 1893 and 37 CFR 1.9 Definitions (a) (1) "*A national application as used in this chapter means a U.S. application for patent which was either filed in the Office under 35 U.S.C. 111, or which entered the national stage from an international application after compliance with 35 U.S.C. 371.*"

Then MPEP 1893.03 states "*Once the national stage application has been taken up by the examiner, prosecution proceeds in the same manner as for a domestic application with the exceptions that: A) the international filing date >(or, if appropriate, the priority date)< is the date to keep in mind when searching the prior art; and B) unity of invention proceeds as under 37 CFR 1.475.*"

Applicant contends the Examiner has not cited the correct legal basis for the restriction when referring to PCT Rule 13 since the application is no longer in the international phase.

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In addition to this argument, it is also Applicant's opinion that the non-unity of invention according to 37 CFR 1.475 should not be raised against the application at this stage since this objection was not raised at the international stage.

Actually, PCT art.27.1 states "*No national law shall require compliance with requirements relating to the form or contents of the international application different from or additional to those which are provided for in this Treaty and the Regulations*". Additionally, according to the PCT Applicant's guide Vol.I; #139 "*An international application which complies with the unity of invention requirements laid down in Rule 13 must be accepted by all the designated and elected Offices, since Article 27(1) does not allow any national law (as defined in Article 2(x)) to require compliance with requirements relating to the contents of the international application different from or additional to those provided for in the PCT.*"

It is therefore applicant's understanding that since no non-unity objection has been raised by the International Search Authority or by the International Examination authority, this objection cannot be raised at the national stage.

Finally, it is applicant's opinion that examiner made a mistake when distinguishing species A1, A2, B1, and B2. As stated in the specification col 11, [0081], Figure 4 relates to "a transverse cross-section of a modified conventional cable", whereas it is said in the office action that species B1 (said to be under Fig.4) "is directed towards a hybrid cable", which is contradictory. Furthermore, as stated in the specification col 11, [0082], Figure 5 relates to "a transverse cross-section of a hybrid cable" whereas it is said in office action that species B2 (said to be under Fig.5) "is directed towards drilling with steel tubing", which is contradictory. This renders the election requirement confusing and applicant, who is obliged to elect "*a single species between A1 and A2 and between B1 and B2*", makes it uncertain how to fulfill the requirement.

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It is then applicant's opinion that any dependent claim from 2 to 31 contains all the limitation of generic claim 1 that is thought to be both novel and inventive over the prior art. The non-unity objection should be void on these grounds also.

Therefore, modification of the restriction requirement and substantive examination of the claims in Species A1, A2, B1, and B2 in the application is respectfully requested.

Applicant believes this reply to be fully responsive to all outstanding issues and place this application in condition for allowance. If this belief is incorrect, or other issues arise, do not hesitate to contact the undersigned at the telephone number listed below.

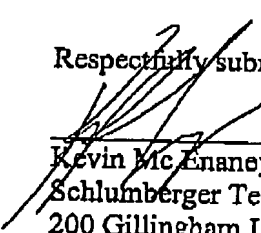
This paper is submitted in response to the Office Action dated March 12, 2007 for which the 31-day due-date for the response is April 12, 2007. The Commissioner is authorized to charge any fee associated with the submission of this response to Deposit Account No. 50-2183 (Ref. No. 21.1268).

The Examiner is invited to contact the undersigned patent attorney at 281.285.7325 with any questions, comments or suggestions relating to the referenced patent application.

Date:

April 26, 2007

Respectfully submitted,


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